

REMARKS

Claims 1-2, 4-12, and 14 -23 are pending in this application. Claims 1, 6, 11, and 23 are independent. In light of the remarks contained herein, Applicant respectfully requests reconsideration and withdrawal of the outstanding rejections.

In the outstanding official action, the Examiner rejected claims 1, 2, 6-8, 11-12, and 18-22 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa (U.S. Patent No. 5,576,768); rejected claims 4, 9, and 14 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa in view of Gatti (U.S. Patent No. 5,719,761); rejected claims 5 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa in view of You (U.S. Patent No. 5,946,046); and rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa in view of Darbee (U.S. Patent No. 6,002,450). Applicant respectfully traverses these rejections.

Applicant wishes to thank the Examiner for indicating claims 15-17 include allowable subject matter.

Claim Rejections Under 35 U.S.C. § 103-Gomikawa

In support of the Examiner's rejection of claim 1, the Examiner admits that Gomikawa fails to teach a second information which is advertisement information. The Examiner further asserts in the Office Action on page 3 "this is very obvious." The Examiner asserts it would have been obvious for a person of ordinary skill to have used the second information display 32 as disclosed by Gomikawa for displaying advertisement information asserting that doing so would efficiently deliver information in a one-to-one manner to a user to enhance availability of information. Applicant respectfully submits that these statements fail to establish prima facie obviousness under 35 U.S.C. § 103.

In order to sustain a rejection under 35 U.S.C. § 103(a) it is respectfully submitted that the Examiner must meet his burden to establish a prima facie case. "To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach all of the claim limitations." *In re Vaeck*, 947 F.2d, 488, 20 USPQ 2nd, 1438 Fed. Cir. 1991.

In establishing his rejection of claim 1, the Examiner admits that Gomikawa fails to teach or suggest all of the claim elements. However, the Examiner fails to provide a properly combinable second prior art reference that cures the deficiencies of the teachings of Gomikawa. As the Examiner has failed to provide references that teach or suggest all of the claim elements, Applicant respectfully submits that the Examiner has failed to establish prima facie obviousness under 35 U.S.C. § 103. For at least this reason, the outstanding rejection should be withdrawn.

In addressing the missing elements of Gomikawa, the Examiner merely asserts "this is very obvious." Applicant maintains that this statement is wholly insufficient to establish prima facie obviousness. The Examiner further concludes it would have been obvious to one skilled in the art to use the second information display to display advertisement information. However, this statement is not supported by any disclosure within Gomikawa. It is well established that the teaching or suggestion to make an asserted combination for modification of the primary reference must be found in the prior art and cannot be gleaned from Applicant's disclosure. *Id.* In other words, the use of hindsight to reconstruct the claimed invention is impermissible. *Uniroyal Inc. v. Rudlan-Wiley Corp.*, 5 USPQ, 1434 Fed. Cir., 1983. As the Examiner's assertions regarding the use of the second information display to display advertising information

is not supported in Gomikawa, it is clear that the Examiner has relied on Applicant's own disclosure to provide motivation in support of his rejection of claim 1. This reliance on Applicant's disclosure is impermissible hindsight reasoning and supports Applicant's assertions that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103.

In addition to the above arguments, Applicant submits that Gomikawa fails to teach the extractor of the present invention. As can be seen in Figure 1, the video signal input terminal 11 is sent to the video signal demodulator 12 for display of the video information. The video signal from input 11 is further sent to caption data extractor 14 for extraction of the caption data. In contrast, the present invention as set forth in claim 1 recites, *inter alia*, an information controller extractor extracting the first and second information from the information received. Gomikawa fails to teach this element as the caption data extractor merely teaches extracting the caption data.

For all the reasons set forth above, Applicant maintains that the Examiner has failed to establish *prima facie* obviousness under 35 U.S.C. § 103 by failing to provide references that teach or suggest all of the claimed elements and by failing to provide proper motivation as required. As such, Applicant respectfully submits that claim 1 is patentable over the cited reference.

In support of the Examiner's rejection of dependent claim 2, the Examiner relies on keyboard 22 of Gomikawa to teach an information transmitting side. Applicant respectfully disagrees with these assertions.

There is no reasonable interpretation that suggests a keyboard is capable of transmitting caption data as asserted by the Examiner. Further, there is no disclosure in Gomikawa that discloses the transmission of caption data from a keyboard 22. The

Examiner's interpretation of Gomikawa is clearly erroneous. As such, Applicant maintains that the Examiner has failed to establish prima facie obviousness by failing to provide references that teach or suggest all of the claimed elements. As such, Applicant respectfully request that the outstanding rejection be withdrawn.

Similarly, with regard to the Examiner's rejection of claim 11, the Examiner relies on keyboard 22 to teach a second information transmitter. As previously asserted, there is no reasonable interpretation that can be made where a keyboard can act as a transmitter. As such, Applicant respectfully submits that the Examiner has failed to establish prima facie obviousness under 35 U.S.C. § 103 by failing to provide references that teach or suggest all of the claimed elements. It is respectfully requested that the outstanding rejection be withdrawn.

With regard to claim 18, the Examiner asserts that Gomikawa discloses the information receiver receiving first and second information through different communication paths citing to a1 and e1. However, Gomikawa clearly discloses that all information is received through input terminal 11. As such, Applicant respectfully submits that the Examiner has failed to provide references that teach or suggest all of the claimed elements and, as such, has failed to establish prima facie obviousness under 35 U.S.C. § 103. It is respectfully requested that the outstanding rejection be withdrawn.

It is respectfully submitted that claims 2 and 20 are allowable for the reasons set forth above with regard to claim 1 at least based on their dependency on claim 1. It is further respectfully submitted that claims 6 and 11 contain elements similar to those discussed above with regard to claim 1 and thus claims 6 and 11, together with claims dependent thereon, are allowable over the cited reference for the reasons set forth above with regard to claim 1.

The Examiner rejected claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa. In support of this rejection, the Examiner asserts as follows:

“As to claim 19, the claim has substantially the limitations of claim 5; therefore, it is analyzed as previously discussed in claim 5 above.”

However, the Examiner rejected claim 5 under 35 U.S.C. § 103(a) as being unpatentable over Gomikawa in view of You. As such, Applicant is unable to ascertain what rejection the Examiner is asserting against claim 19 and further is unable to discern what portions of which references the Examiner is relying upon to render claim 19 obvious. Applicant respectfully requests the Examiner clarify his rejection of claim 19, and, should the Examiner rely on the teachings of You to support his rejection of claim 19, Applicant respectfully requests that the Examiner properly establish prima facie obviousness in a new non-final Official Action.

With regard to claims 20-22, the Examiner asserts that Gomikawa teaches first information being independent of second information but fails to provide any support for this assertion. Applicant disagrees that Gomikawa teaches this claimed element and directs the Examiner's attention to column 4, lines 42-47 where Gomikawa clearly teaches that the first and second information are dependent. As the Examiner has failed to provide a reference that teaches or suggests all of the claimed elements, Applicant respectfully submits that claims 20-22 are allowable over the cited reference.

Claim Rejections Under 35 U.S.C. § 103- Gomikawa/Darbee

In support of his rejection of claim 23, the Examiner asserts that claim 23 differs from claim 1 by the additional element “the information display device is a remote controller.” As noted above with regard to claim 1, there are substantial deficiencies in the Examiner's rejection of claim 1, and, as such, Applicant respectfully submits that

claim 23 is patentable over the references as cited for at least the reasons noted above with regard to claim 1.

CONCLUSION

All objections and rejections raised in the Office Action having been addressed, it is respectfully submitted that the present application is in condition for allowance and such allowance is respectfully solicited. Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327), to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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